

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1, 2, 4-13, 20-27, 31, 33-48, 52-61, 65-76, and 81-88 are pending in this application. Since no new issues are presented, it is respectfully requested that the Examiner enter the response on the record. The response will place the Applicant's position in better form for appeal. No new matter is added.

Claims 1, 2, 4-13, 20-23, 25, 26, 31, 47, 52, 54-61, 67, 69, 70-74, 75-77, 80, 81, and 83-88 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldstein (U.S. patent 5,410,326, hereinafter Goldstein) in view of Niimi et al. (U.S. patent 5,996,028, hereinafter "Niimi"). Claims 24, 27, and 53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldstein in view of Niimi and in further view of Hirose (U.S. patent 5,917,915).

The present application relates to a remote control unit and associated method of initiating an interactive operation between the remote control unit and an electronic apparatus.¹ The remote control unit receives information from an electronic apparatus under the control of the remote unit. The information received from the electronic apparatus may be stored by a detachable memory. In an exemplary embodiment, coupon information can be provided from the electronic apparatus to the remote control unit and then selectively stored into the detachable memory. With such a structure, a user of the remote control unit can remove the memory from the remote control unit and redeem the coupon information at a retail location.²

Claim 1 recites, *inter alia*, a control device including:

¹ Specification at Figure 1.

² Specification at pages 31-32.

“...an output unit for outputting the additional information received by the receiver to a display device;
a memory for storing at least a portion of said additional information, the memory including a detachable IC memory card, based on a user controlled input...”

Applicants respectfully traverse the rejection of Claim 1 under 35 U.S.C. §103. The basic requirements for a *prima facie* case of obviousness are (1) there must be some suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference must teach or suggest all the claim limitations. It is respectfully submitted that the outstanding Office Action fails to make a *prima facie* case of obviousness, because there is no suggestion or motivation to modify Goldstein with Niimi. Furthermore, even if Goldstein and Niimi were to be combined the combination fails to teach or suggest all the limitations recited in Claim 1.

The outstanding rejection relies on Goldstein as disclosing a memory and storing information therein directed to favorite channel information.³

In Goldstein's device, information is transmitted to the remote control unit from the television receiver or head-end unit allowing the remote unit to display available content information (i.e., channels available to the user) based upon a user's subscription to a cable television service for example.⁴ Goldstein describes that a user's favorite channel information can be determined by monitoring the keypad usage of the remote control device, and storing the keypad history information in the remote control device for identifying a favorite channel.⁵ In other words, Goldstein describes an operation for recording favorite channel information “by monitoring keypad selections 470 of the touch-sensitive screen 10 in

³Office Action of April 21, 2004, page 5, paragraph 2.

⁴Goldstein at column 12, lines 13-33.

⁵Goldstein at column 26, lines 15-39.

a particular mode of interest”.⁶ Thus, in Goldstein the favorite channel information is stored in the remote control unit; however, the content information received from an electronic apparatus (head-end unit, or television receiver) is not stored in memory of the remote control based on a user’s input.

The Office Action states that “it is clear that the control device is well capable of controlling and receiving information from an electronic device.”⁷ This assertion in the Official Action appears to be based on Goldstein’s remote control device communicating bi-directionally with a television receiver that receives programming information from a head end cable of a remote data source, and the cable system and head end downloads information to the remote control device.⁸ However, as stated in the Official Action, Goldstein describes that the information downloaded from the television receiver and head-end device is operational data necessary for the remote to function in accordance with a user’s service contract.⁹ This operational data is not additional data as recited in the claims, stored based upon a user control, but is instead data necessary to allow the remote to function. Thus, Goldstein fails to disclose or suggest additional information transmitted from the head-end device, or television receiver, selectively stored based on user interaction.

Moreover, no teachings in Niimi can overcome the above-noted deficiencies in Goldstein.

Accordingly, Applicant requests that the rejection of Claim 1 under 35 U.S.C. § 103(a) be withdrawn. Claims 7-13, 47, 60, and 75 recite substantially the same limitations discussed above and, therefore also patentably define over Goldstein and Niimi.

⁶ Goldstein at column 26, lines 27-29.

⁷ Office Action of April 21, 2004, page 2, paragraph 3.

⁸ Goldstein at column 3, lines 17-44.

⁹ Office Action of April 21, 2004, at page 4.

As discussed above, Goldstein, neither alone nor in combination with Niimi, disclose or suggest the Applicants' invention as recited in Claim 1. Likewise, Hirose does not remedy the deficiencies noted above, and therefore, none of the cited references, neither alone nor in combination, can be properly asserted as disclosing or suggesting Applicants' remaining dependent Claims 2, 4-6, 20-27, 31, 33-46, 48, 52-, 59, 61, 65-74, 76, and 81-88, which included the above distinguished limitations by virtue of their independent recitation or dependency. Therefore, the Official Action does not provide a *prima facie* case of obviousness with regard to any of these claims.

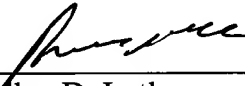
Accordingly, Applicants respectfully requests the rejection of Claims 1, 2, 4-14, 20-27, 31, 33-48, 52-61, 65-76, and 81-88 under 35 U.S.C. §103 be withdrawn.

Should the above distinctions be found unpersuasive, Applicants respectfully request that the Examiner provide an explanation via Advisory Action pursuant to MPEP 714.13 specifically rebutting the points raised herein for purposes of facilitating the appeal process.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 1, 2, 4-14, 20-27, 31, 33-48, 52-61, 65-76, and 81-88 is patentably distinguishing over the prior art. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of the application is therefore requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/03)
GJM:SNS:asa/rac

I:\ATTYATH\PROSECUTION\20's\205602-US\205602US-AM3-A.DOC